

09/826,680
Art Unit 3622
Docket 8717

REMARKS

This Amendment is submitted in response to the Office Action mailed on July 28, 2005. Claims 16 - 30 are pending, and all stand rejected at present. Claims 31 and 32 are added. No fee is due.

SUMMARY OF MAJOR POINTS OF THIS AMENDMENT

Applicant's Specification Cannot be Used as a Reference

The Office Action relies on Applicant's own Specification as a reference, in order to show numerous claim elements. That is not allowed. The Specification is not prior art.

The Office Action is apparently assuming that the Background of the Specification describes an existing device, and is apparently relying on such a device. However, if such a device exists, the PTO must prove the existence independently of Applicants' Specification.

Further, Applicants point out that the Inventors are residents of Great Britain, and that the Specification was first filed in Great Britain. Thus, it is reasonable to assume that, if the Background does describe an existing device, that device existed in Great Britain.

Devices existing in a foreign country are not prior art under section 102. The situation may be different if the devices are described in a printed publication. However, the **mere existence** of a device in a foreign country does not provide prior art. This

09/826,680
Art Unit 3622
Docket 8717

is explained below.

Therefore, Applicant's Specification cannot be used as a reference. This fact alone defeats all rejections.

**MPEP Requires (1) Teaching and (2) Expectation of Success
AND
These Must be Shown in Prior Art, not in Applicants' Disclosure**

The rejection fails to comply with the last paragraph in the passage given below, which is taken from MPEP § 706.02(j).

Contents of a 35 U.S.C. 103 Rejection

. . . .

To establish a prima facie case of obviousness, three basic criteria must be met.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

Second, there must be a reasonable expectation of success.

Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure.

The absence of compliance with the last paragraph is illustrated by an example. In rejecting claim 16, the Office

Action, page 3, second paragraph, relies on characteristics of the invention, **as described in Applicants' Specification**, in formulating a rationale for combining the Lawlor reference with Applicant's Specification.

Thus, the "teaching or suggestion" is partly based on Applicants' disclosure, contrary to the last paragraph of the MPEP passage cited above.

A similar comment applies to the expectation of success. The Office Action relies on features described in the Specification, to show usefulness of its combination of "references."

Even if "References" are Combined, Invention is not Attained

All claims recite an ATM, Automated Teller Machine. Many claims recite presenting advertising to an ATM customer, during a transaction. For example, claim 16 recites that the advertising is displayed "while the ATM customer is conducting the cash dispense transaction at the ATM."

The Lawlor reference is cited to show this recitation.

However, Lawlor is concerned with "home banking." His customers use personal computers, to perform "home banking." In fact, Lawlor touts one advantage of his system, namely, that his customers need not actually visit ATMs. (Column 4, lines 24 - 29.)

Therefore, Lawlor has not been shown to

-- perform a cash-dispensing transaction (his

customers' PCs do not dispense cash),
-- present advertising to customers at ATMs,
nor
-- present advertising at ATMs while
customers perform transactions.

Consequently, even if Lawlor is combined with Applicant's Specification (which is not allowed), claim recitations such as that of claim 16, discussed above, are not found.

No Teaching Given for Combining "References"

The rejections of all independent claims follow the same pattern, and the rejection of claim 16 is typical. (See Office Action, page 3.)

The rejection asserts that

-- Part A of the claim is shown by Applicants' Specification (incorrectly being used as a reference),
-- the rest of the claim is found in Lawlor, and
-- Part A "would" use the subject matter of Lawlor, because some supposedly beneficial effect is attained.

This rejection is invalid, for at least three reasons.

09/826,680
Art Unit 3622
Docket 8717

Reason 1

One reason is that this type of rejection is no different from a type of rejection **specifically prohibited** by the MPEP.

MPEP § 2143.01 states:

FACT THAT REFERENCES **CAN BE** COMBINED OR
MODIFIED IS NOT SUFFICIENT TO ESTABLISH PRIMA
FACIE OBVIOUSNESS

The mere fact that references can be combined
or modified does not render the resultant
combination obvious unless the prior art also
suggests the desirability of the combination.

. . . .

FACT THAT THE CLAIMED INVENTION IS **WITHIN THE
CAPABILITIES OF ONE OF ORDINARY SKILL IN THE
ART** IS NOT SUFFICIENT BY ITSELF TO ESTABLISH
PRIMA FACIE OBVIOUSNESS

A statement that modifications of the prior
art to meet the claimed invention would have
been "well within the ordinary skill of the
art at the time the claimed invention was
made" because the references relied upon teach
that all aspects of the claimed invention were
individually known in the art is not
sufficient to establish a prima facie case of
obviousness without some objective reason to
combine the teachings of the references.

The rejection, in essence, is no different from the rejections
prohibited by the MPEP.

Reason 2

A second reason is that the PTO's rationale for combining the

09/826,680
Art Unit 3622
Docket 8717

"references" does not actually lead to the claims. Claim 16 provides an example.

The PTO's rationale (page 3, second paragraph, last sentence), in essence, states that Lawlor's targeted advertising reaches customers better.

But that rationale does not lead, as a matter of logic, to the claim recitation of presenting advertising during a transaction at an ATM. At best, that rationale leads to the use of targeted advertising, which is completely different.

Reason 3

As stated, the rationale for adding Lawlor is that he teaches targeted advertising, which provides a benefit. (Office Action, page 3, second paragraph, last sentence.)

However, that rationale, as a matter of logic, does not lead to a combination of the "references."

If you want targeted advertising, with the accompanying benefits, then use Lawlor's system. You do not need an ATM to obtain the benefits.

The rationale does not actually lead to a combination of Lawlor with an ATM. This conclusion is further supported by the fact that Lawlor recognizes the existence of ATMs, but does not himself suggest using ATMs for advertising, as claimed.

09/826,680
Art Unit 3622
Docket 8717

Comment

Not all points raised in this Summary are elaborated below.
Some are considered self-explanatory.

END SUMMARY

RESPONSE TO OBVIOUSNESS REJECTIONS

All claims were rejected as obvious, based on Applicant's Specification and a Lawlor patent.

Applicant's Specification Cannot be used as Reference

Reason 1

MPEP § 2143.03 states:

To establish prima facie obviousness . . . **all the claim limitations** must be taught or suggested **by the prior art**.

MPEP § 706.02(j) states:

. . . .

To establish a prima facie case of obviousness, three basic criteria must be met.

. . . .

Finally, **the prior art reference** (or references when combined) must teach or suggest all the claim limitations.

The Office Action, in relying on Applicant's Specification to show elements of every claim, fails to comply with these MPEP

09/826,680
Art Unit 3622
Docket 8717

sections. The Office Action must show the claim elements **within the prior art**. That has not been done.

Reason 2

Applicant's Specification is a pending application. MPEP § 901.03 states:

Pending Applications

Except as provided in 37 CFR 1.11(b), pending U.S. applications are preserved in confidence (37 CFR 1.14(a)) and are not available as references.

That is, this MPEP section states that Applicant's Specification, as a "pending application," is "not available as a reference."

Reason 3

It is axiomatic that references used under section 103 must qualify as prior art under section 102. However, the content Applicant's Specification (the "Content" herein) upon which the PTO relies do not so qualify as prior art. Individual parts of section 102 will now be considered.

SECTION 102(a)

POINT 1

The Content has not been shown to be "known or used **by others in this country**" as required.

In this connection, it is pointed out that the Inventors herein appear to be residents, or citizens, or both, of Great Britain. This Application was filed in Great Britain prior to filing in the U.S. Thus, even if it be assumed that the Content describes items in commercial use, it is reasonable to assume that those items were in use in Great Britain.

Such items are not available as prior art. One reason is the literal language of section 102(a).

Another is the public policy that a patentable discovery may lie in the observation of machines/processes/etc. in foreign countries, and the importation of those machines/etc. into the U.S. The person acting as the importer is treated as the U.S. inventor. (See Professor Chisum's treatise on Patents, § 3.05[5], which discusses sections 102(a) and 102(g), and is entitled "In This Country.")

Therefore, the Content has not been shown to be "known or used **by others in this country**" as required.

POINT 2

The Content has not been shown to be "patented or described

09/826,680
Art Unit 3622
Docket 8717

in a printed publication" as required.

POINT 3

The Content has not been shown to be "patented or described in a printed publication **before the invention thereof by the applicant**" as required. (The Content could be describing Applicants' own work.)

SECTION 102(b)

The Content has not been shown to be in existence "more than one year prior to" Applicants' filing date.

SECTION 102(c)

This section (on abandonment) is clearly inapplicable.

SECTION 102(d)

This section (on seeking foreign patent protection prior to seeking U.S. patent protection) is clearly inapplicable.

SECTION 102(e)

The Content is not shown in an "application" or "patent" "by another," as required..

SECTION 102(f)

09/826,680
Art Unit 3622
Docket 8717

This section is not relevant, because it does not define a type of prior art. It only states that a person who did not "invent the subject matter" cannot obtain a patent.

SECTION 102(g)

POINT 1

The sub-section on interferences does not apply.

POINT 2

The Content is not shown to have been "made in this country," as required.

CONCLUSION

Therefore, to be used as a reference, the Content must be shown in prior art as defined in section 102. As just explained, no part of section 102 defines the Content as prior art.

Rebuttal of Apparent Assumption Made by PTO - Part I

The Office Action is apparently assuming that, since much of the Content is found in Applicant's "Background of the Invention," therefore the Content is describing known prior art.

That is not necessarily so, for at least the following reasons.

One reason is that a Background of the Invention can describe

09/826,680
Art Unit 3622
Docket 8717

uses, or needs, for an invention described later in the Specification. In so doing, the Background shows that the invention has a "use" (ie, is "useful"), as required by section 101.

Another reason is that, if an Inventor discovers a problem in the prior art, the Inventor is allowed to patent a solution to the problem, even if the solution is obvious. (One rationale is that the problem itself is not described in the prior art.) Thus, a Background of the Invention can describe a problem which the Inventor discovered within the prior art. (See MPEP § 2141.02, section headed "DISCOVERING SOURCE/CAUSE OF A PROBLEM IS PART OF "AS A WHOLE" INQUIRY.")

Therefore, these two reasons, and others, refute any conclusion that statements made in a Background of the Invention necessarily qualify as prior art.

Rebuttal of Apparent Assumption Made by PTO - Part II

There is no authority for the PTO's assumed proposition that some parts of a patent application are prior art, and other parts are not. MPEP § 608.01(a), and the regulations it cites, states that the "Background of the Invention" is **part of** the Specification.

The Specification is not prior art.

MPEP § 901.03, cited above, states that the Specification, as

09/826,680
Art Unit 3622
Docket 8717

a pending application, is not available as a reference. And the PTO has cited no authority to the contrary.

Even if References are Combined, Claims are not Attained

Claim 16, last sub-paragraph, states, speaking generally, that an advertisement is displayed **during the cash-dispensing transaction**. And the dispensing takes place at an ATM, Automated Teller Machine.

The Office Action cites three passages of Lawlor to show this:

- 1) Column 15, lines 54 - 67;
- 2) Column 30, line 56 - column 31, line 59;
- and
- 3) Column 39, lines 45 - 48.

However, passage (1) merely states that advertising is presented to customers for "5 - 7 seconds after they SIGNON." That does not show the claimed display of advertising **during the cash-dispensing transaction** at an ATM.

Passage (2) merely discusses passage (1) in greater detail. It states that, after the customer enters his PIN (Personal Identification Number), a "timed advertisement" is then displayed to the customer. (Column 31, line 11.)

Significantly, passage (2) is **directly contrary** to the claim recitation in question. Passage (2), at column 31, lines 60 et seq., states that **after** the advertising is presented, the customer

09/826,680
Art Unit 3622
Docket 8717

proceeds with his financial transaction. That is contrary to the claimed recitation of displaying advertising **during the cash-dispensing transaction.**

Passage (3), and its context, indicate that the customer is given **two choices**: (A) see advertising or (B) see a "main menu," wherein the customer can execute a financial transaction. Again, that is contrary to the claimed recitation of displaying advertising **during the dash-dispensing transaction.** The customer chooses one, or the other, that is, advertising or transaction.

Therefore, claim 16, last sub-paragraph, is not found in Lawlor, even if combined with the Content.

**Even if Applicants' Background is Accepted as Prior Art,
Claim 16 is Still not Attained by Addition of Lawlor**

Lawlor Reference

The cited passages of Lawlor show neither dispensing cash, nor doing so at an ATM.

Lawlor is concerned with "home banking," wherein customers use personal computers to shift money around electronically. (Column 6, line 62 et seq.)

But no cash is dispensed in Lawlor.

Applicability of Lawlor to Rejection

The Office Action, page 3, asserts that

1) Applicants' Background fails to show displaying of advertising while the customer is conducting a cash dispense transaction **at an ATM,**

and

2) Lawlor "targets advertisements to users of an ATM terminal while the user is conduct[ing] a transaction at the ATM terminal."

In support of assertion (2), the Office Action cites the three passages of Lawlor discussed above.

However, none of those passages support assertion (2).

Lawlor's customer is **nowhere near** an ATM.

Lawlor states:

One aspect of the invention . . . involves using the ATM . . . **network** . . . as a data communications netowrk for conducting banking financial transactions from homes and offices.

(Column 1, lines 18 - 22.)

This statement indicates that

1) Lawlor's customers do not use ATMs themselves, but the ATM **network**, and

2) Lawlor's customers are present at their "homes and offices," where ATMs do not exist.

Lawlor further states that using an ATM has the disadvantage

09/826,680
Art Unit 3622
Docket 8717

of requiring the customer to **travel** to the ATM. (Column 4, lines 24 - 29.)

Therefore, assertion (2) above is not correct. Nothing has been shown in Lawlor which indicates that

1) advertising should be displayed to a customer **at an ATM**,

nor

2) that the advertising should be displayed **during a cash-dispensing transaction.**

Consequently, even if Lawlor is combined with Applicants' Background, claim 16 is not attained.

No Teaching Given for Combining Background with Lawlor

Point 1

No reasoning has actually been given which leads, as a matter of logic, to combining Lawlor with Applicants' Background.

Instead, the Office Action, page 3, first full paragraph merely asserts that "it **would have been obvious**" to combine Lawlor with the Background. (Second-to-last sentence.) The Office Action then asserts that the Background system "would use" Lawlor for a specific purpose.

This type of rejection is **specifically prohibited** by the MPEP. MPEP § 2143.01 states:

FACT THAT REFERENCES **CAN BE** COMBINED OR
MODIFIED IS NOT SUFFICIENT TO ESTABLISH PRIMA
FACIE OBVIOUSNESS

The mere fact that references **can be** combined
or modified does not render the resultant
combination obvious unless the prior art also
suggests the desirability of the combination.

. . .

FACT THAT THE CLAIMED INVENTION IS **WITHIN THE
CAPABILITIES OF ONE OF ORDINARY SKILL IN THE
ART** IS NOT SUFFICIENT BY ITSELF TO ESTABLISH
PRIMA FACIE OBVIOUSNESS

A statement that modifications of the prior
art to meet the claimed invention would have
been **"well within the ordinary skill of the
art at the time the claimed invention was
made"** because the references relied upon teach
that all aspects of the claimed invention were
individually known in the art is not
sufficient to establish a prima facie case of
obviousness without some objective reason to
combine the teachings of the references.

The reasoning applied by the Office Action is fundamentally
no different than the type of reasoning which is **specifically
prohibited** by this MPEP section.

Point 2

As a matter of logic, the PTO's reasoning does not lead to a
combination of the "references."

The stated goal of the PTO's reasoning is to identify
customers, in order to target the customers with advertising which
is relevant to the customers. (Office Action, page 3, first full

paragraph, last sentence.)

However, that does not lead to a combination of the "references." Lawlor, **by himself**, accomplishes that goal..

Restated, if the PTO wants to target customers with relevant advertising, then the PTO need only use the Lawlor reference. An ATM is not needed.

Point 3

Even if the goal of the PTO (targeting customers with relevant advertising) is combined with Applicants' Background, claim 16 is still not attained.

Claim 16 does not recite merely presenting advertising to customers. It states that advertising is presented **during the cash dispensing transaction**. The PTO's goal does not lead to that.

Rejection Fails to Comply with Dembiczak Decision

The rejection does not follow the CAFC's decision of In re Dembiczak, 175 F. 3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999).

In brief, Dembiczak states that

- **objective evidence** of a teaching for combining references must be provided;
- the Examiner's speculation does not qualify as objective evidence;
- numerous sources can provide a teaching to

combine references;

-- knowledge of one skilled in the art can
act as a source;

-- however, THE RANGE OF SOURCES AVAILABLE
DOES NOT DIMINISH THE REQUIREMENT FOR ACTUAL
EVIDENCE;

-- broad conclusory statements by the
Examiner do not qualify as evidence; and

-- "particular factual findings" as to the
teaching are required, and gives reasons why
facts are necessary.

In this case, no **facts** have been set forth in favor of
combining the "references." Stating that ATMs "would use" Lawlor's
system, as the Office Action does on page 3, does not qualify as
"objective evidence" as required by Dembiczak.

Claim 17

Dependent claim 17 states that a program in the ATM
"execute[s] a Web browser." Lawlor is cited to show claim 17.

However, the PTO cites two passages in Lawlor to show claim
17, namely,

1) column 20, lines 52 - 67

and

2) column 31, lines 50 - 59.

09/826,680
Art Unit 3622
Docket 8717

Neither passage discusses a Web browser. Neither passage discusses executing a Web browser at an ATM.

Therefore, claim 17 has not been shown in Lawlor. MPEP § 2143.03 states:

To establish prima facie obviousness . . . **all the claim limitations** must be taught or suggested by the prior art.

Claim 18

Applicants point out that dependent claim 18 states that a "program" in the ATM allocates "space" to a "browser" at specific times. ("Space" means space in time, not literal space in three dimensions.)

The Office Action has not shown claim 18 in the prior art. Instead, the Office Action asserts that Lawlor transmits "timed" advertisements to browser programs at ATM terminals. (As explained above, this assertion is false. Lawlor's customers, the targets of his advertising, do not use ATM terminals.)

The Office Action then concludes that claim 18 follows from this (false) assertion. However, several problems exist in this conclusion.

Problem 1

The claimed action of causing a program at an ATM to grant time to a "browser" does not follow from the notion that

09/826,680
Art Unit 3622
Docket 8717

advertising is transmitted to an ATM. No browser is needed for Lawlor's advertising. And no "program" is needed to grant space (or time) to the (non-required) "browser."

Problem 2

The Office Action has shown no "browser" in Lawlor.

Problem 3

Since no "browser" has been shown in Lawlor, it is reasonable for Applicants to ask why a "browser" would be used.

A "browser" allows a customer to surf the internet. But Lawlor does not appear to state that his customers surf the internet in pursuit of the advertising in question. Instead, Lawlor's system chooses the advertising which is displayed to the customers.

No browser is needed for that.

Therefore, since

- 1) no "browser" has been shown in Lawlor
and
- 2) it has just been shown that no need exists
for a "browser" in Lawlor,

it is reasonable to conclude that Lawlor suggests no "browser."

Since the claimed "browser" is absent, the claimed "program" which allocates space to the (absent) browser is also absent.

Claims 19 and 20

The discussion above applies to claims 19 and 20.

Claim 21

In one form of the invention, an ATM acts like a billboard, and "sells" advertising time. The ATM charges for the number of times each advertisement is displayed. Claim 21 sets forth an approach to billing in this context.

Claim 21 has not been shown in Lawlor. The Office Action, page 7, asserts that Lawlor charges for each advertisement distributed. Even if that be true, that does not show claim 21, which recites:

21. A method according to claim 20,
further comprising the steps of:

logging the number of times the advertisement
database has been accessed by each ATM; and

applying a charge to each advertisement based
on the number of accesses.

Applicants request, under 37 CFR §§ 1.104(c)(2) and 35 U.S.C. § 132, that the PTO specifically identify the "advertising database" and the "accesses" in Lawlor.

Further, parent claim 20 states that the advertising in question is displayed at an ATM. Applicants request that this be

09/826,680
Art Unit 3622
Docket 8717

identified in Lawlor.

Applicants point out that claim 21 states that the charges are "based on the number of accesses." The Office Action asserts that Lawlor charges for each advertisement distributed. That is different.

Claims 22 - 30

The discussion above applies to claims 22 - 30.

Added Claims

Added claims 31 - 35 state that the advertising is displayed while the cash is being counted and staged. Support for this recitation is found in the Specification, page 1, line 15.

Lawlor does not show this recitation. One reason is that Lawlor does not dispense cash.

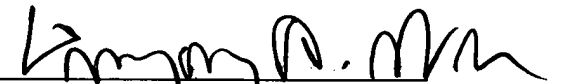
09/826,680
Art Unit 3622
Docket 8717

CONCLUSION

Applicant requests that the rejections to the claims be reconsidered and withdrawn.

Applicant expresses thanks to the Examiner for the careful consideration given to this case.

Respectfully submitted,


Gregory A. Welte
Reg. No. 30,434

NCR Corporation
1700 South Patterson Blvd.
WHQ - 4
Dayton, OH 45479
October 28, 2005

(937) 445 - 4956